

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I: Claims 1-9, drawn to chemiluminescence enhancers;

Group II: Claims 10-12, drawn to a chemiluminescence method; and

Group II: Claims 13-15, drawn to a detection reagent kit.

Applicants have elected Group II, claims 10-12, with traverse, in view of the following reasons.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required. (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctions. (M.P.E.P. § 803). Moreover, when making a lack of unity invention requirement in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group (i.e., why there is no single inventive concept), specifically describing the unique special technical feature in each group. (M.P.E.P. § 1893.03(d)). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing any reasons and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct, or providing any reasons and/or examples to support any conclusion that the groups lack unity of invention.

The Examiner asserts that Groups I-III do not relate to a single general inventive concept under PCT Rules 13.1 and 13.2, because they lack the same or corresponding special technical features. The Examiner alleges that Groups I-III share the feature of chemiluminescence enhancer of Group I, and that this feature is described in the disclosure of U.S. Patent No. 5,112,960.

The Examiner, however, has not considered that the claims in each group are considered related inventions under 37 C.F.R. § 1.475(b), in which the inventions are considered to have unity invention. Applicants submit that while PCT Rules 13.1 & 13.2 are applicable, 37 C.F.R. § 1.475(b) provides, in relevant part, that “a national stage application containing claims to different categories of invention will considered to have unity of invention if the claims are drawn only to . . . (3) A product, process specially adapted for the manufacture of said product, and a use of said product.” In the present application, claims 1-9 (Group I) are drawn to chemiluminescence enhancers, claims 10-12 (Group II) are drawn to a method of making the chemiluminescence enhancers, and claims 13-15 (Group III) are drawn to detection reagent kit that uses the chemiluminescence enhancers. Thus, as the relationship of the claims meets the unity of invention requirements, the restriction is believed to be improper.

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper.

For the reasons set forth above, Applicants request that the Requirement for Restriction be withdrawn.

Applicants request that if the invention of Group II is found to be allowable, withdrawn Groups I and III (which include the limitations of the allowable claims), be rejoined.

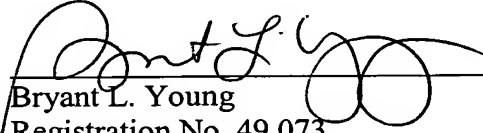
Application No. 10/518,586

Reply to Office Action of September 30, 2005

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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